

1

REMARKS

2

3 Applicant respectfully requests reconsideration and allowance of all of
4 the claims of the application. Claims 1-14 are presently pending. Claims
5 amended herein are 1-14. Claims cancelled herein are none. New claims added
6 herein are none.

7 Herein, the "Action" or "Office Action" or "Office" refers to the Office
8 Action dated March 14, 2003.

9

Prior Art Status of References

10 Applicant does not explicitly or implicitly admit that any reference is
11 prior art. Nothing in this communication should be considered an
12 acknowledgement, acceptance, or admission that any reference is considered
13 prior art.

14

Independent Claims

15 Applicant amends claims 2-5, 8, and 11-14 so that they are now written
16 in a clearly independent format.

1

2 Substantive Claim Rejections

3

4

5 Claim Rejections under §102

6

7 The Office rejects all pending claims under §102. For the reasons set
8 forth below, the Office has not made out a *prima facie* case of anticipation (i.e.,
9 §102). Accordingly, Applicant respectfully requests that the rejections be
10 withdrawn and the case be passed along to issuance.

11 The Office's rejections are based upon the following reference: Lin: Lin
12 *et al.*, US Patent No. 6,421,748.

13 Anticipation Rejections

14 The §102 (Anticipation) Standard

15 In making out a §102 rejection, the Federal Circuit has stated that a
16 reference anticipates a claim if it discloses every element of the claim. *See*
17 Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed.
18 Cir. 1991); Richard v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir.
1989).

20 Thus, anticipation is determined by "identify[ing] the elements of the
21 claims, determin[ing] their meaning in light of the specification and
22 prosecution history, and identify[ing] corresponding elements disclosed in the
23 allegedly anticipating reference." Lindermann Maschinenfabrik GMBH v.
American Hoist & Derrick Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984).

24 Consequently, if any claimed element is missing from the allegedly
25 anticipating reference, then anticipation is negated. Kloster Speedsteel AB v.
Crucible Inc., 793 F.3d 1565, 1571 (Fed. Cir. 1987). Close is not enough.

1 Every element in the claim must exist in the allegedly anticipating reference for
2 the §102 rejection to stand.

3

4 **Based upon Lin**

5 The Office rejects claims 1-14 under 35 USC § 102(e) as being
6 anticipated by Lin. Applicant traverses this rejection.

7

8 **Claim 1**

9 The Office indicates that Lin discloses all of the features of this claim.
10 Applicant submits that Lin does not.

11 Claim 1 recites, “a source-selection determiner configured to determine
12 a source selected for a Mopy in a Mopy job *from multiple sources* on the MFD
13 [emphasis added].”

14 On page 3 of the Action, the Office indicates that Lin discloses this and
15 cites col. 2, lines 57-67 and col. 3, lines 1-8 for support. Applicant respectfully
16 submits that Lin does not disclose, teach, or suggest “a source-selection
17 determiner” as recited in claim 1. More particularly, Lin does not disclose,
18 teach, or suggest such at col. 2, lines 57-67 and col. 3, lines 1-8.

19 Instead, Lin discloses a “listing and selecting interface 102” for
20 “displaying all available *output* devices accessible in the network, such as
21 printers, overhead projectors, viewers, and fax machines [emphasis added].”

22 Applicant submits that Lin’s interface for “displaying...*output* devices” is not a
23 “source-selection determiner configured to determine a source.” Rather, it
24 appears to be the opposite.

25 At col. 3, lines 4-8, Lin discloses that the interface 102 may be used to
“select any desired property for the document output, such as, paper size,
resolution, number of copies, etc. [emphasis added].” The Office seems to

1 conclude that the selection of such properties infers that Lin must include the
2 ability to select a source from multiple sources.

3 The Applicant submits that the ability to select document properties
4 does not infer the ability to select from multiple sources. Instead, Lin's
5 selection interface allows the selection of output properties and not, as is
6 claimed, "determin[ation of] a *source* selected for a Mopy in a Mopy job."

7 Applicant submits that there is nothing disclosed in Lin indicating that a
8 selection of a document property is equivalent to selection of a source amongst
9 multiple sources. With Lin, the user is incapable of actually selecting a single
10 source, it never discloses of the capability of selecting from multiple sources.

11 According to the above reasons, Applicant asks the Office to withdraw
12 its rejections.

13 Claim 2

14 Claim 2 is allowable for the same reasons given for claim 1 above.

15 According to the above reasons, Applicant asks the Office to withdraw
16 its rejections.

17 Claims 3-5

18 These claims are allowable for the same reasons given for claim 1
19 above.

20 According to the above reasons, Applicant asks the Office to withdraw
21 its rejections.

22 Claims 6 - 8

23 These claims are allowable for the same reasons given for claim 1
24 above.

1 According to the above reasons, Applicant asks the Office to withdraw
2 its rejections.

3 Claims 9-14

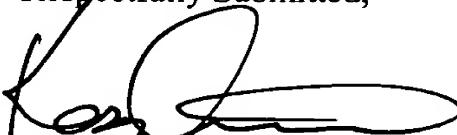
4 The Office indicates that these claims are of similar scope as claim 1 and
5 therefore are rejected under the same rationale given for rejection of claim 1. If
6 so, then Applicant submits that these claims are allowable for the same reasons
7 given above for the allowability of claim 1.

8 According to the above reasons, Applicant asks the Office to withdraw
9 its rejections.

10 Conclusion

11 All pending claims are in condition for allowance. Applicant
12 respectfully requests reconsideration and prompt issuance of the application. If
13 any issues remain that prevent issuance of this application, the Office is urged
14 to contact the undersigned attorney before issuing a subsequent Action.

15 Dated: 6-02-03

16 Respectfully Submitted,
17 By: 
18 Kasey C. Christie
19 Reg. No. 40559
20 (509) 324-9256 x232
21 kasey@leehayes.com
22 www.leehayes.com